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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,519	11/24/2003	Satoshi Yamamoto	Q78576	1977

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/718,519

Applicant(s)

YAMAMOTO ET AL.

Examiner

Olga Asinovsky

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/2003</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to an acrylic resin comprising an acrylic resin (1) and an acrylic resin (2), classified in class 525, subclass 163, 221, 227.
  - II. Claims 8-9, drawn to an adhesive composition comprising a mixture of an acrylic resin (1) and acrylic resin (2), and a hardener and a silane-based compound, classified in class 525, subclass 326.5 and class 523, subclass 176, and class 524, subclass 261, 533 and 560.
  - III. Claims 10-13, drawn to an optical laminate film comprising (I) an optical film and (II) an adhesive composition layer obtained by mixing an acrylic resin (1) and an acrylic resin (2) specified in the independent claim 10, classified in class 428, subclass 1.33.
  - IV. Claims 14-15, drawn to an optical laminate comprising (X) an optical laminate film comprising (I) an optical film and (II) an adhesive composition layer specified in the independent claim 14, and (XX) a glass material layer, classified in class 428, subclass 355AC.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Groups II+III+IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product

Art Unit: 1711

(MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a molding solid composition for making a sheet article and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Inventions of Group II and Groups III+IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functional and different effects, because the invention of Group II can be used in the form of a latex for coating purposes on to a substrate, wherein a substrate is not an optical film or glass material.

4. Inventions of Group III and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and different effects, because Group IV requires a glass material layer.

Art Unit: 1711

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with John Callahan on September 16, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. (During the telephone conversation on September 16, 2005 with the attorney, the examiner promised to search a hardener and a silane-based compound for further possibility to rejoin Group II with Group I.)

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1711

- a. Claims 1, 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0875 546 B1.

Parish discloses an acrylate-based coating composition comprising a resin component, multifunctional acrylate components and a catalyst component, col. 7, lines 45-50. A resin component may include unsaturated acrylic resin, col. 1, lines 56-58, col. 2, lines 1-5 and 28-45, col. 3, lines 1-35. The unsaturated acrylic resin is readable in applicants' claims for being an acrylic resin (2). The multifunctional acrylate components include a monofunctional (meth)acrylate that is readable for being a unit (i) in applicants' claims, col. 4, lines 3-15. Also, a multifunctional acrylate component includes difunctional (meth)acrylates, col. 4, lines 16-27. The difunctional (meth)acrylates are readable in applicants' claims for being a unit (ii) having at least two olefinic double bonds such as di(meth)acrylates. Any additional (meth)acrylates having a polar moiety is readable in applicants' claimed monomer (iii) in the present claim 5, see col. 4, lines 29-36. A free radical initiator, col. 4, line 55, would be expected in applicants' claims for the polymerization of the (meth)acrylates monomers. The resin system may include an accelerating agent to accelerate curing=hardening process, col. 5, lines 30-45. An accelerating agent would be expected in the present claims, and a said accelerating agent is readable in claim 8 if this claim would be rejoined. The composition comprises polymethylsiloxanes, col. 6, line 50.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 875 546 B1 as applied to claims 1 and 5-6 above.

The ratio of the content of selected monomers (i) and (ii) in the present claims and the acrylic resin (1) and the acrylic resin (2) could be obtained in EP'546. It would have been obvious to one of ordinary skill in the art to use the acrylate-based coating composition in EP'546 wherein the amount of an unsaturated acrylic resin and a multifunctional acrylate component and a monofunctional acrylate component can be selected in the amount specified in the present claims because the formulation of the coating composition is depending on the desired crosslink density of the coating, col. 3, lines 34-35 and the curing rate.

***Claim Rejections - 35 USC § 112***

11. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1711

The term "methacrylate" is confusing in claim 1 because a methacrylate in the formula (A) has a radical R1 being hydrogen or methyl. Examiner suggests include (meth)acrylate that will define an acrylate and methacrylate.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References have been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*O. A.*

September 14, 2005

Olga Asinovsky  
Examiner  
Art Unit 1711



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700